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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,055	11/16/2001	Dan A. Steinberg	A1148.0000/P008 (51948)	7843
7590	03/26/2004		EXAMINER	
Jonathan D. Baskin c/o Edwards & Angell, LLP PO Box 9169 Boston, MA 02209			THOMPSON, TIMOTHY J	
			ART UNIT	PAPER NUMBER
			2873	

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/988,055

Applicant(s)

STEINBERG ET AL.

Examiner

Timothy J Thompson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19-29 is/are allowed.
- 6) ☒ Claim(s) 1,3,4,12,30-33,35,37 and 38 is/are rejected.
- 7) ☒ Claim(s) 2,5-11,13-18,34,36 and 39-41 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/01.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4, 12, 30-33, 35, 37, 38 are rejected under 35

U.S.C. 102(anticipated) as being anticipated by Trott et al.(US. Patent No. 5,862,283).

Regarding claim 1, Trott et al. discloses an optical device having a planar surface(fig 4, 32); a substrate having an upper surface and a plurality of pits(fig 4, 31, 51, 52); and a positioning mechanism disposed in each said pit(fig 4, 41), wherein said optical device contacts said positioning mechanisms and is positioned on said substrate such that said planar surface is tilted relative to said upper surface(fig 11 and col 4, lines 1-20, 49-67).

Regarding claim 3, Trott et al. discloses each of the positioning mechanism is a spheres(fig 4).

Regarding claim 4, Trott et al. discloses at least one of the spheres are a different size than the remainder of said spheres(col 4, lines 41-50).

Regarding claim 12, Trott et al. discloses an optical device having at least one cut-out portion(fig 4, 32, fig 11, 152); a substrate having an upper surface and a plurality of pits(fig 4, 31, 51, 52); and a positioning mechanism disposed in each said pit(fig 11, 165), wherein said positioning mechanisms contact said at least one cut-out portion.

Regarding claim 30, Trott et al. discloses a method for positioning an optical device on an upper surface of a substrate, said method comprising: mounting a plurality of positioning mechanisms in predetermined locations on said substrate; mounting an

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optical device having a planar surface on said positioning mechanisms wherein said planar surface is tilted relative to said upper surface; and anchoring the optical device(claims 1-8, col 3, line 40 through col 4, line 67).

Regarding claim 31, Trott et al. discloses said mounting of a plurality of positioning mechanisms in predetermined locations comprises positioning a plurality of spheres on said upper surface of said substrate(claim 1).

Regarding claim 32, Trott et al. discloses forming a plurality of pits on said upper surface of said substrate, said pits being sized and configured to receive said spheres(claim 2).

Regarding claim 33, Trott et al. discloses said anchoring comprises affixing the optical device to the substrate(claim 8).

Regarding claim 35, Trott et al. discloses affixing the optical device to at least one of the positioning mechanisms(claim 9).

Regarding claim 37, Trott et al. discloses for positioning an optical device on an upper surface of a substrate, the method comprising: mounting a plurality of positioning mechanisms in predetermined locations on said substrate; forming at least one cut-out portion on an mounting said optical device on said substrate such that said at least one cut-out portion contacts at least one said positioning mechanisms; and anchoring the optical device(claims 1-8, col 3, line 40 through col 4, line 67).

Regarding claim 38, Trott et al. discloses said forming comprises forming a plurality of pits sized and configured to receive said positioning mechanisms(claim 2).

***Allowable Subject Matter***

Claims 2, 5-11, 13-18, 34, 36, 39-41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. With the allowable features being the positioning mechanisms are pillars, the optical devices includes one or more grooves being sized and figured; a mechanism having a lateral adjustment mechanism for laterally positioning the optical device; the optical device and the substrate include metal, and the affixing being soldering the optical device to the substrate or the positioning mechanism; a plurality of grooves sized and configured to receive said positioning mechanisms; grooves to extend perpendicular to an optical axis of the optical device; a plurality of cut-out portions.

Claims 19-29 are allowed.

The following is an examiner's statement of reasons for allowance: The prior art taken either singularity or in combination fails to anticipate or fairly suggest the limitations of the independent claim, in such a manner that a rejection under 35 U.S.C. 102 or 103 would be proper. The prior art fails to teach a combination of all the claimed features as presented in independent claims 19, with the allowable feature being . Therefore claims 19-29 are allowed.

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Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Thompson whose telephone number is (571) 272-2342. If the examiner can not be reached his supervisor, Georgia Epps, can be reached on (571) 272-2328.

  
T.J.T.

3/15/04